IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
GROUP ART UNIT 1753

EXAMINER: Edna Wong
APPELLANT: Paskalov et al.
SERIAL NO: 10/698,867
FILED: 10/30/2003
FOR: High Energy Disinfection of Waste

Commissioner of Patents and Trademarks
Washington, D.C. 20231
Attention: Board of Patent Appeals and Interferences

APPELLANT'S REPLY BRIEF UNDER 37 CFR §41.37

This reply brief is file in response to the Supplemental Examiner's Answer filed December 20, 2007. The Applicant respectfully requests that the appeal filed October 29, 2007 be maintained under 37 CFR 41.41.

Old Rejections

A. Rejection Of Claims 12-20 Under 35 U.S.C. §112, First Paragraph, As Failing To Comply With The Written Description Requirement.

The Examiner argued that the limitation recited in independent claim 12 "without subjecting the waste directly to the plasma" was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention (See Supplemental Examiner's Answer, P3-5). The Applicant disagrees.

The entire limitation recited in independent claim 12 is actually "without subjecting the waste directly to a plasma generated by the RF plasma wave generator." An RF plasma wave generator with a quartz tube closed reactor is expressly taught in the incorporated parent application ser. No. 10/432,208 ("the '208 application). (See '208 Specification, para [0019], lines 1-5) Additionally, the conduit carrying the waste past the waves radiated by the RF plasma wave generator is substantially water tight. (See Current Specification, P5/L4-8) Under such conditions, the waste can not be subjected directly to the plasma generated by the RF plasma

wave generator. One of ordinary skill in the art would understand the inventors to have possession of the claimed invention at the time the application was filed.

The Examiner also argued that the limitation recited in claim 12 "without subjecting the waste directly to the plasma" lacks literal basis in the specification as originally filed. (See Supplemental Examiner's Answer, P4 "there is found no literal support in the specification for the newly added limitation in amended claim 12").

As the Applicant previously stated, literal basis is not the proper test. The proper test for a 35 U.S.C. §112 rejection is whether the specification reasonably conveys to one of ordinary skill in the art that the inventor had possession of the claimed invention as of the filing date. *See In re Kaslow*, 707 F.2d 1366 (Fed. Cir. 1983) ("The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language.")

B. Rejection of claims 15-17 and 20 under 35 U.S.C. 112, second paragraph

The Examiner argued that the relationship between the limitation "treating the waste at a rate of at least 20 l/hr" and the limitation of "conditions" is unclear because there is no connection claimed between treating the waste at a rate of at least 20 l/hr and carrying the waste past the waves radiated by the RF plasma wave generator. (See Supplemental Examiner's Answer, P15)

Here again the Examiner is applying the wrong test. The test for definiteness under 35 U.S.C. 112, second paragraph, is whether "those skilled in the art would understand what is claimed when the claim is read in light of the specification." *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576, 1 USPQ2d 1081, 1088 (Fed. Cir. 1986). That test is satisfied. The limitation is explained in detail on P4/L22-P5/L3 of the current specification.

It is unclear why the examiner keeps applying the wrong test, and why, if another test is being argued, the examiner fails to provide support for that other test.

New Rejections

C. Rejection of claims 12-14 under 35 U.S.C. 102(b)

The Examiner argued that the limitation "without subjecting the waste directly to a plasma generated by the RF plasma wave generator" was taught by Laroussi since the water is exposed to irradiation for a period of time. (See Supplemental Examiner's Answer P7-8) This is simply not true. Looking at Fig 1 of Laurossi, the water (labeled 110) is directly subjected to the plasma (labeled 120).

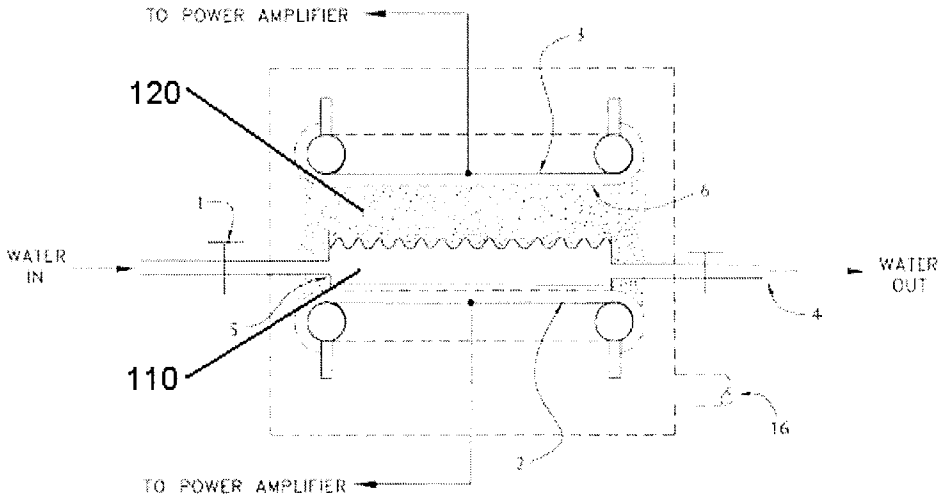


FIG. 1

Additionally, reference character 5 does not show a "closed container" as the Examiner argued. (See Supplemental Examiner's Answer P8) The top of the container is obviously open, as shown by the waves of plasma 120 entering the top of the container.

D. Rejection of claims 15-20 under 35 U.S.C. 103(a)

On pages 8-12 of the Supplemental Examiner's Answer, the Examiner brought up new 103 rejections. However, these are previous rejections that were already presented by the Examiner in the Office Action dated March 26, 2007, and were already withdrawn in the Examiner's Office Action dated August 8, 2007. Withdrawn rejections can not be revived under the guise of a "new rejection."

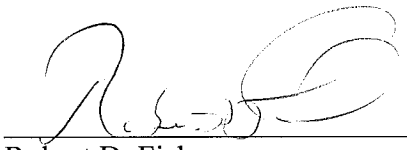
> There is no new ground of rejection when the basic thrust of the rejection remains the same such that an appellant has been given a fair opportunity to react to the rejection. See *In re Kronig*, 539 F.2d 1300, 1302-03, 190 USPQ 425, 426-27 (CCPA 1976). (**MPEP 1207.03** – III Situations That Are Not Considered New Grounds of Rejection)

It would not be proper for the Examiner in this case, after having forced the Applicant to spend the time and money appealing invalid rejections, to withdraw the matter from appeal.

CONCLUSION

The pending claims are all allowable as written. The Examiner is being overly pedantic in applying 35 U.S.C. 112, is ignoring the applicable case law, is creating her own spurious interpretations of the law, is ignoring clearly referenced portions of the specification, and is now even casting old rejections as "new" in her answer. The rejections should be over-ruled.

Respectfully submitted,



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